

REMARKS/ARGUMENTS

I. Status of the Application

Claims 18-27 are pending in the instant application. These claims were added pursuant to a preliminary amendment filed in conjunction with a request for continued prosecution under 37 CFR § 1.17(e). Then pending claims 1-13 and 15-17 were cancelled. In conjunction with these amendments, the Examiner has withdrawn the previous grounds of rejection and set forth new rejections and objections in the Office Action dated September 23, 2003, which is addressed below.

In the present Office Action, the Examiner states that claims 18-22 would be allowable if (1) rewritten or amended to overcome the 35 U.S.C. § 112, second paragraph, rejections and (2) limited to reducing degradation caused by the presence of ozone. Applicants thank the Examiner for this indication of allowable subject matter and have amended claims 18-22 to comply with the Examiner's suggestions. In addition, as set forth below, Applicants claims 23-27 have been amended in accordance with the Examiner's views and should also be allowable based on the same reasoning as for claims 18-22.

II. Sequence Listing

The Examiner objects that the application does not comply with 37 CFR §§ 1.821-1.825 because Applicants did not provide certain "Sequence Listing" material. In this regard, the Examiner noted an oligonucleotide sequence set out in the specification at page 23, line 7. Applicants thank the Examiner for directing their attention to this matter. As requested by the Examiner, Applicants have reviewed the entire application and the sole sequence invoking the requirements of a Sequence Listing is that oligonucleotide sequence pointed out by the Examiner.

In response to this objection regarding lack of a sequence listing, Applicants provide the following:

- (1) An initial computer readable form copy of the "Sequence Listing" and
- (2) An initial paper copy of the "Sequence Listing" as well as an amendment directing its entry into the specification.

The content of the paper and the computer readable copies are the same and contain no new matter as required by 37 CFR §§ 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).

In view of these amendments and submissions, Applicants respectfully submit that the instant objection is obviated.

III. The Claims As Amended Fully Comply with the Written Description Requirement

The Examiner has rejected claims 18-27 under 35 U.S.C. § 112, first paragraph, on the grounds that the application fails to comply with the written description requirement. In particular, the Examiner states that the claimed "method of reducing degradation" (claim 18) and "method for fabricating an oligonucleotide array" (claim 23) are not sufficiently supported by the specification because, in the Examiner's view, the scope of those expressions and claims is not supported by an adequate disclosure in the specification regarding degradation caused by means other than ozone.

Applicants respectfully disagree with the Examiner and believe that the claims as drafted are supported by an adequate disclosure in the specification. However, to remove any issue that the claim scope sought is overbroad with respect to the disclosure of the specification, applicants have amended both independent claims, as suggested by the Examiner, to specifically recite that the degradation covered by the claims is that caused by ozone. Thus, claim 18 now specifically recites "[a] method of reducing ozone related degradation of an oligonucleotide on an array during fabrication of said array" (Emphasis added). Likewise independent claim 23 now recites "[a] method for ~~fabricating~~ preventing ozone related degradation of an oligonucleotide array" (Emphasis added).

Protection of arrays from ozone degradation is discussed at length in the application. See, e.g., pp. 15-16 and Example 2. The claims as amended are fully supported by the

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application's disclosures regarding ozone. In view of the above, Applicants respectfully submit that the grounds of the instant rejection have been overcome and obviated.

IV. The Claims Particularly Point Out and Distinctly Claim the Invention

The Examiner has rejected the claims under 35 U.S.C. § 112, second paragraph, on a number of grounds. In each case, Applicants have amended the claims to obviate the Examiner's grounds of rejection.

- A) In claims 18-22, the Examiner objected to the phrase "method of reducing degradation" as being overly broad in scope. As discussed above, while Applicants are respectfully of the opinion that the phrase is fully supported by the specification and claims considered in their totality, Applicants have amended this phrase to recite that the claimed method is limited to "ozone related degradation," as suggested by the Examiner, obviating this ground of rejection.
- B) The Examiner objected to the term "manufacturing" in the last phrase of claim 18 as lacking proper antecedent basis and suggested that fabrication was appropriate. Applicants have adopted the Examiner's suggestion in this regard, obviating this ground of rejection.
- C) The Examiner rejected claims 23-27 as being incomplete and indefinite because in the Examiner's view the preamble recited a method for fabricating, whereas no fabrication steps were referred to in the body. As set forth above, Applicants have amended claims 23-27 to recite "[a] method for ~~fabricating~~ preventing ozone related degradation of an oligonucleotide array" This amendment obviates the instant ground of rejection.
- D) The Examiner also rejected claims 23-27 as "confusing" based on the grounds set forth above in C. Applicants respectfully submit that the amendments discussed immediately above specifically obviate the Examiner's rejection regarding confusion.

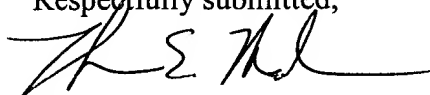
IV. Conclusion

Consideration and allowance of all pending claims is respectfully requested. If a telephone conversation with Applicants' attorney would expedite prosecution of the above-identified application, the Examiner is urged to call the undersigned at (408) 731-5875.

Further, applicants respectfully request that this paper be treated as an appropriate petition for a one month extension of time. The Examiner is hereby authorized to deduct any necessary fees in this regard from applicants' deposit account no. 01-0431.

Dated: 1/22/04

Respectfully submitted,



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